

REMARKS

Claims in the Application. Claims 30-34 have been cancelled from this application. Claims 35 and 37 have been amended. Claims 43-45 have been added to this application. Accordingly, Claims 23-29 and 35-45 are active in this application. Reconsideration is respectfully requested.

Examiner's Rejection of the Claims Under 35 U.S.C. § 102(e). The Examiner has rejected Claims 23-28 and 30-40 under 35 U.S.C. § 102(e) over U.S. Patent No. 6,252,167 ("*Rose*"). This ground for rejection is traversed.

The Examiner continues to argue that the "support", illustrated in FIG. 5 as element "24", is equivalent to the claimed gasket. This is incorrect. While element "24" in FIG. 5 refers to a support, the function of the support is to hold the gasket, an intumescent material being applied to the gasket. Note that lines 62-63 of column 6 of *Rose* refer to "support 24 *for* the intumescent material". Lines 19-20 of column 6 of *Rose* states that the intumescent material is *applied to* the support. Note further lines 57-65 of column 3 of *Rose*:

The **support 24** may be made of any suitable material which **can absorb or otherwise to which can be applied a sufficient quantity of intumescent material 30**. For example, **the support may be a gasket on which a layer of intumescent material 30 has been applied** to one side. The support 24 may be comprised of one or more layers. Alternatively, **the support 24 could be a piece of plastic or metal on which a layer of intumescent material 30 has been applied**. The actual materials used for the support 24 are not important, **so long as the intumescent material 30 remains applied to the support 24**. The support 24 is attached to the electrical box 12 so that the intumescent material 30 faces toward the interior of the electrical box 12. (Emphasis added.)

In Applicant's invention, the gasket serves as the "fire retardant material" (Claim 23) which may comprise an intumescent material (Claim 28). In independent Claim 30, the gasket *is* intumescent. Since the support of *Rose* is *not* the equivalent of the fire retardant gasket of Applicant, FIG. 5 does not illustrate the claimed embodiment.

The Examiner's reliance on FIG. 1 and lines 18-21 of column 1 to support his position that *Rose* discloses a method of assisting a compromised barrier is further misplaced. Lines 18-21 of column 1 refer to the prior art and are directed to installation of an electrical device, within a box, into a wall. Applicants do not dispute that the placement of electrical boxes into walls is novel. What is novel is the claimed method of assisting a compromised barrier by use of a gasket fire retardant material in between a faceplate and electrical box. A gasket fire retardant material is not disclosed in *Rose*.

The Examiner further fails to continue the effect of the preamble upon the claimed limitations, in accordance with established precedent. The Examiner, by failing to consider the Federal Circuit's more recent rulings, fails to appreciate the patentability of the claims.

Examiner's Rejection of Claims 29 and 41-42 Under 35 U.S.C. § 103(a). The Examiner has further rejected Claims 29 and 41-42 under 35 U.S.C. § 103(a) as being unpatentable over *Rose* in view of Applicants' alleged admission. Applicants respectfully traverse this rejection because the alleged admission does not cure the defects of *Rose*. As such, the combination of *Rose* and Applicants' own specification cannot render the claims obvious because such combination would not teach of one skill in the art the claimed method of assisting the compromised barrier using a fire retardant gasket for reasons stated above.

Examiner's Rejection of the Claims Under 35 U.S.C. § 112. The Examiner has further rejected Claims 23-36 under the second paragraph of 35 U.S.C. § 112. This ground for rejection is likewise traversed.

The second paragraph requires that the specification conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which Applicants regard as their invention. The purpose of the second paragraph is to ensure that those skilled in the art

can determine with precision the metes and bounds of the claims. According to the Federal Circuit, the issue of indefiniteness must be focused on whether those skilled in the art would understand the scope of the claim when the claim is read in light of the rest of the specification. *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1565, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986).

In its discussion of the prior art, Applicants clearly indicate the desirability of the process to reestablish a fire rating of the barrier. The claims state that the process is capable of “at least partially reestablishing a fire rating of the barrier.” Those of skill in the art would understand the terminology employed in the claims of Applicants. Barriers typically exhibit maximum fire ratings of 1, 2, 3 or 4 hours. A 4-hour maximum rated barrier having gaskets rated for 2 hours would only be capable of partially reestablishing the fire rated barrier (for 2 hours). A 2-hour maximum rated barrier having gaskets rated for 2 hours would be capable of completely reestablishing its fire rating. Thus, the claimed terminology of “at least partially reestablishing a fire rating of the barrier” is not indefinite to those of skill in the art.

The facts in the instant case are most similar to those in *In re Marosi*, 710 F.2d 799, 803, 218 USPQ 289, 292 (Fed. Cir. 1983) wherein the Federal Circuit held that a claim element specifying a compound to be “essentially free of alkali metal” was not indefinite. The Court in *Marosi* indicated that the issue of indefiniteness should be resolved only after examining the objectionable phrase in light of the specification. Deciding indefiniteness solely on usage of the term in the claim is improper. When examined in light of the specification, it is clear that the claimed phrase “at least partially reestablishing a fire rating of the barrier” is not indefinite. A person of ordinary skill in the art would readily recognize from the specification how a fire

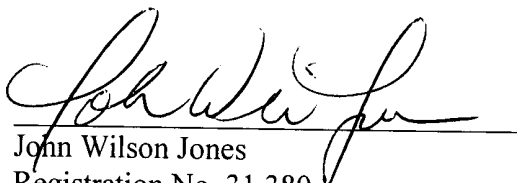
rating of a barrier can be partially reestablished. As such, in light of *Marosi*, the language "at least partially reestablishing a fire rating of the barrier" is not indefinite.

Examiner's Objection to the Drawings. Lastly, the Examiner has objected to the drawings under 37 CFR 1.83(a). The Examiner states that the barrier recited in Claims 23, 30 and 35 and fire-rated barrier recited in Claim 37 must be recited in the drawings. These elements are shown in the drawings as element "2". Note the discussion of the barrier in lines 14-16, and fire-rated barrier specifically in line 2, of page 4 of the originally filed specification.

Conclusion. The Examiner is respectfully requested to telephone the undersigned should he deem it prudent to expedite the prosecution of this application into a Notice of Allowance.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.6(d)

I hereby certify this correspondence is being transmitted on this 10 day of October, 2003, under 37 CFR 1.6(d), to facsimile number 703 305-3431 in the United States Patent and Trademark Office.

Date: October 10, 2003


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